REMARKS

By this Amendment, Applicants amend claims 1, 2, 7, 8, and 14 for clarity and to more appropriately define the present invention. Claims 1-14 remain pending in the application.

In the Office Action, the Examiner rejected claims 1-14 under 35 U.S.C. § 102(e) as anticipated by Suzuki (U.S. Patent No. 6,129,274). Applicants respectfully traverse the rejection. To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8th ed., Aug. 2001), quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Claim 1 recites a "method of providing advertisements to an automated service machine over a network" including, among other steps, "selecting, from a server coupled to the network, an advertisement based upon the information identifying the user." Suzuki does not disclose at least these features.

By contrast, the Suzuki system requires a customer to use an ID card to access in-store kiosk terminals to gather information about various items the customer might purchase. When the customer selects items for purchase, the kiosk terminal writes information describing the merchandise to the customer's ID card. In addition, the kiosk terminal can read the customer's personal demographic profile information contained on the ID card to make recommendations regarding promotional items that the customer

might be interested in. See col. 7, lines 7-57. A kiosk that reads demographic profile information from an ID card and makes recommendations, however, does not constitute at least "selecting, from a server coupled to the network, an advertisement based upon the information identifying the user," as recited in claim 1. Since <u>Suzuki</u> does not teach each and every element of claim 1, <u>Suzuki</u> does not anticipate claim 1. The Examiner should thus withdraw the rejection and allow claim 1.

Claims 2-6 depend from allowable claim 1. Claim 14, while of a different scope, includes recitations similar to allowable claim 1. For at least the same reason discussed above in connection with allowable claim 1, the Examiner should also allow claims 2-6 and 14.

Claim 7 recites a "system for providing advertisements" including, among other things, "a server, coupled to a network, the server comprising a first memory for storing information describing a profile of at least one user and a second memory for storing data for a plurality of advertisements." As discussed above, in the <u>Suzuki</u> system, a customer's personal demographic profile information is contained on an ID card. However, this does not constitute at least "a server . . . storing information describing a profile of at least one user and . . . storing data for a plurality of advertisements," as recited in claim 7. As a result, <u>Suzuki</u> does not teach each and every element of claim 7. Accordingly, <u>Suzuki</u> does not anticipate claim 7 and the Examiner should withdraw the rejection.

Claim 8 recites an "automated service machine coupled to a network" including, among other things, "a communications interface for requesting an advertisement from a server coupled to the network based upon the information identifying the user." As

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discussed above, in the Suzuki system, a kiosk reads demographic profile information from an ID card and makes recommendations to the customer. However, this does not constitute at least "a communications interface for requesting an advertisement from a server coupled to the network based upon the information identifying the user," as recited in claim 8. The Suzuki system, therefore, does not teach each and every element of claim 8. Accordingly, Suzuki does not anticipated claim 8 and the Examiner should withdraw the rejection.

Claims 9-13 depend from allowable claim 8. For at least the same reason discussed above in connection with allowable claim 8, the Examiner should also allow claims 9-13.

Moreover, in the Office Action, the Examiner did not address any of the individual recitations of any claim, other than making a broad allegation regarding claims 1-14, and reciting a few elements from various claims. See Office Action, page 2. Applicants respectfully note that the Examiner is obligated to show how the prior art teaches **all** claim elements of Applicants' invention. See M.P.E.P. § 2121. With the exception of the Examiner's allegations that Suzuki teaches various claim elements and citations to large portions of the Suzuki on page 2 of the Office Action, the Examiner has not provided any explanation of how Suzuki supposedly teaches each and every recitation of each claim. In fact, the Examiner failed to mention the majority of the recitations of the pending claims and instead has grouped the claims together in one general rejection. This, however, is improper and Applicants respectfully note that the Examiner's action should be complete as to all matters. See M.P.E.P. § 707.07. For at

least these additional reasons, the Examiner has not demonstrated that <u>Suzuki</u>

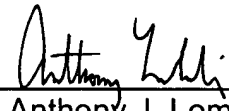anticipates each and every element of claims 1-14.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully requests reconsideration

and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: January 5, 2005   By:_____
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